



22 DEC 2006

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Commissioner for Patents
United States Patent and Trademark Office
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In re Application of
Nielsen et al.
Application No.: 10/509,696
PCT No.: PCT/DK03/00213
Int. Filing Date: 02 April 2003
Priority Date: 03 April 2002
Attorney Docket No.: 9663.74USWO
For: Laser System

DECISION

ON

PETITION

This is in response to the renewed petition under 37 CFR 1.47(a) filed on 06 September 2006.

DISCUSSION

In a decision mailed on 03 March 2006, the petition under 37 CFR 1.47(a) filed on 12 August 2005 was dismissed without prejudice because

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of joint inventor Martin Egede Nielsen be excused because "numerous attempts have been made to obtain the signature of Mr. Nielsen with respect to the declaration of inventorship of the present application. Mr. Nielsen has refused the numerous attempts." ...

Counsel has not adequately substantiated his assertion that Mr. Nielsen has refused to sign the declaration under the standard enunciated above. The evidence of record provides no showing that a complete copy of the application papers was provided to Mr. Nielsen, along with the oath or declaration document, prior to his alleged refusal to execute the oath or declaration. Thus, Mr. Nielsen's alleged repeated failure to respond to communications does not constitute a refusal to execute the oath or declaration within the meaning of 37 CFR 1.47(a).

In response, petitioner filed a declaration signed by Mr. Nielsen on 28 September 2006. This declaration does not render the petition under 37 CFR 1.47(a) moot because the declaration is defective. Specifically, it includes an un-initialed alteration. As such, it would not be appropriate to accept said declaration under 37 CFR 1.497(a) and (b).

Petitioner introduces copies and translations of correspondence allegedly sent to Mr. Nielsen by Susanne Hamberg and Holm Schwarze. It is unclear whether petitioner (Dennis Daley) has first-hand knowledge of the circumstances surrounding these letters; if not, submission of statements made on the basis of first-hand knowledge from the individuals who prepared and mailed them would be appropriate.

The translation of the letter dated 21 June 2006 and bearing the name of Susanne Hamberg indicates that "a complete copy of the application" and a "combined inventor statement/power of attorney and an assignment" (a declaration of inventorship?) were sent therewith. Mr. Nielsen's response dated 28 June 2006 does not include an explicit refusal to

execute the application; rather, it could be interpreted as a request to provide a corrected declaration document nominating a different inventive entity - to wit, the inventive entity whose members are enumerated in Mr. Nielsen's letter. It is noted that the translation of the letter dated 16 August 2006 and signed by Holm Schwarze addresses the issue of the identity of the proper inventive entity ("the invention was, pursuant to Esko-Graphic's view of the case, made exclusively by the two persons listed in the documents"). However, the time period between the mailing of this letter to Mr. Nielsen and the filing of the instant renewed petition was not clearly adequate for the letter to reach Mr. Nielsen, for the points raised to be considered by him, and for a signed declaration to be returned by him. Indeed, the declaration filed on 28 September 2006 appears to have been signed by Mr. Nielsen on 14 September 2006, 8 days after the filing of the instant renewed petition. *Prima facie* not *enuf time*

The fact that Mr. Nielsen executed the declaration which subsequently was filed on 28 September 2006 further calls into question whether he in fact refused to execute the application. Though the declaration is defective because it includes an un-initialed alteration, his signature of this document suggests that he may have been persuaded by the arguments raised as to the identity of the inventive entity by Holm Schwarze in the letter dated 16 August 2006. As such, it appears reasonable that Mr. Nielsen may be willing to execute an acceptable declaration (e.g., one without un-initialed alterations or other defects) if counsel adequately explains to him the significance of doing so. Therefore, based on the totality of the evidence currently of record, it would not be appropriate to conclude that Mr. Nielsen has "refused" to execute the application within the meaning of 37 CFR 1.47(a).

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



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